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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,755	04/27/2005	Jordi Tormo I Blasco	5000-0120PUS1	9144
2292 7590 07/31/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
KLINKEL, KORTNEY L.				
ART UNIT		PAPER NUMBER		
1615				
NOTIFICATION DATE		DELIVERY MODE		
07/31/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/532,755

**Applicant(s)**

BLASCO ET AL.

**Examiner**

Kortney Klinkel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

NOTE: Claim 13 provides for the use of the compounds I and II for preparing a composition...but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Furthermore, the claimed invention outlined by claim 13 is directed to non-statutory subject matter. The claimed invention does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter). For these reasons, claim 13 has not been assigned in a group.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I(a), claim(s) 1-7 in part, drawn to a fungicidal mixture and composition comprising a triazolopyrimidine derivative of formula I and bromuconazole.

Group I(b), claim(s) 1-7 in part, drawn to a fungicidal mixture and composition comprising a triazolopyrimidine derivative of formula I and difenoconazole.

Group I(c), claim(s) 1-7 in part, drawn to a fungicidal mixture and composition comprising a triazolopyrimidine derivative of formula I and diniconazole.

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Group I(d), claim(s) 1-7 in part, drawn to a fungicidal mixture and composition comprising a triazolopyrimidine derivative of formula I and fenbuconazole.

Group I(e), claim(s) 1-7 in part, drawn to a fungicidal mixture and composition comprising a triazolopyrimidine derivative of formula I and fluquinconazole.

Group I(f), claim(s) 1-7 in part, drawn to a fungicidal mixture and composition comprising a triazolopyrimidine derivative of formula I and flusilazole.

Group I(g), claim(s) 1-7 in part, drawn to a fungicidal mixture and composition comprising a triazolopyrimidine derivative of formula I and hexaconazole.

Group I(h), claim(s) 1-7 in part, drawn to a fungicidal mixture and composition comprising a triazolopyrimidine derivative of formula I and prochloraz.

Group I(i), claim(s) 1-7 in part, drawn to a fungicidal mixture and composition comprising a triazolopyrimidine derivative of formula I and tetraconazole.

Group I(j), claim(s) 1-7 in part, drawn to a fungicidal mixture and composition comprising a triazolopyrimidine derivative of formula I and triflumizole.

Group I(k), claim(s) 1-7 in part, drawn to a fungicidal mixture and composition comprising a triazolopyrimidine derivative of formula I and flutriafol.

Group I(l), claim(s) 1-7 in part, drawn to a fungicidal mixture and composition comprising a triazolopyrimidine derivative of formula I and myclobutanil.

Group I(m), claim(s) 1-7 in part, drawn to a fungicidal mixture and composition comprising a triazolopyrimidine derivative of formula I and penconazole.

Group I(n), claim(s) 1-7 in part, drawn to a fungicidal mixture and composition comprising a triazolopyrimidine derivative of formula I and simeconazole.

Group I(o), claim(s) 1-7 in part, drawn to a fungicidal mixture and composition comprising a triazolopyrimidine derivative of formula I and ipconazole.

Group I(p), claim(s) 1-7 in part, drawn to a fungicidal mixture and composition comprising a triazolopyrimidine derivative of formula I and triticonazole.

Group I(q), claim(s) 1-7 in part, drawn to a fungicidal mixture and composition comprising a triazolopyrimidine derivative of formula I and prothioconazole.

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Group II(a), claim(s) 8-11 in part, drawn to a method for controlling fungi with the mixture of group I(a).

Group II(b), claim(s) 8-11 in part, drawn to a method for controlling fungi with the mixture of group I(b).

Group II(c), claim(s) 8-11 in part, drawn to a method for controlling fungi with the mixture of group I(c).

Group II(d), claim(s) 8-11 in part, drawn to a method for controlling fungi with the mixture of group I(d).

Group II(e), claim(s) 8-11 in part, drawn to a method for controlling fungi with the mixture of group I(e).

Group II(f), claim(s) 8-11 in part, drawn to a method for controlling fungi with the mixture of group I(f).

Group II(g), claim(s) 8-11 in part, drawn to a method for controlling fungi with the mixture of group I(g).

Group II(h), claim(s) 8-11 in part, drawn to a method for controlling fungi with the mixture of group I(h).

Group II(i), claim(s) 8-11 in part, drawn to a method for controlling fungi with the mixture of group I(i).

Group II(j), claim(s) 8-11 in part, drawn to a method for controlling fungi with the mixture of group I(j).

Group II(k), claim(s) 8-11 in part, drawn to a method for controlling fungi with the mixture of group I(k).

Group II(l), claim(s) 8-11 in part, drawn to a method for controlling fungi with the mixture of group I(l).

Group II(m), claim(s) 8-11 in part, drawn to a method for controlling fungi with the mixture of group I(m).

Group II(n), claim(s) 8-11 in part, drawn to a method for controlling fungi with the mixture of group I(n).

Group II(o), claim(s) 8-11 in part, drawn to a method for controlling fungi with the mixture of group I(o).

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Group II(p), claim(s) 8-11 in part, drawn to a method for controlling fungi with the mixture of group I(p).

Group II(q), claim(s) 8-11 in part, drawn to a method for controlling fungi with the mixture of group I(q).

Group III(a), claim(s) 12, drawn to a seed comprising the mixture of group I(a).

Group III(b), claim(s) 12, drawn to a seed comprising the mixture of group I(b).

Group III(c), claim(s) 12, drawn to a seed comprising the mixture of group I(c).

Group III(d), claim(s) 12, drawn to a seed comprising the mixture of group I(d).

Group III(e), claim(s) 12, drawn to a seed comprising the mixture of group I(e).

Group III(f), claim(s) 12, drawn to a seed comprising the mixture of group I(f).

Group III(g), claim(s) 12, drawn to a seed comprising the mixture of group I(g).

Group III(h), claim(s) 12, drawn to a seed comprising the mixture of group I(h).

Group III(i), claim(s) 12, drawn to a seed comprising the mixture of group I(i).

Group III(j), claim(s) 12, drawn to a seed comprising the mixture of group I(j).

Group III(k), claim(s) 12, drawn to a seed comprising the mixture of group I(k).

Group III(l), claim(s) 12, drawn to a seed comprising the mixture of group I(l).

Group III(m), claim(s) 12, drawn to a seed comprising the mixture of group I(m).

Group III(n), claim(s) 12, drawn to a seed comprising the mixture of group I(n).

Group III(o), claim(s) 12, drawn to a seed comprising the mixture of group I(o).

Group III(p), claim(s) 12, drawn to a seed comprising the mixture of group I(p).

Group III(q), claim(s) 12, drawn to a seed comprising the mixture of group I(q).

The inventions listed as Groups I(a)-III(q) do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The instant claims are drawn to a combination of a triazolopyrimidine derivative, which is known in the art (see WO 98/46607, as per Applicant's IDS), with a series of structurally different azole compounds which are also known in the art (see EP 531837, EP 645091 and WO 97/06678, all as per Applicant's IDS). The combination of the triazolopyrimidine with the various azoles is not explicitly shown in the art, however the 17 different combinations comprise structurally different azoles which means the claims lack the same or corresponding special technical feature. PCT Rule 13 which pertains to the Unity of Invention states that, "[t]he international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." Furthermore, 37 CFR 1.475 part (b) states the following: "An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
  - (2) A product and a process of use of said product; or...", emphasis added.
- Applicant's claims are drawn to **multiple** compositions (Group I) and a seed (Group III) and **multiple** methods of use of said compound (Groups II).

Accordingly, Groups I-III are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process



claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Due to the complicated nature of the restriction, the restriction requirement is being made via written correspondence in lieu of a telephone interview.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kortney Klinkel whose telephone number is (571)270-5239. The examiner can normally be reached on Monday-Friday 8am to 5pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached at (571)272-8373. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KLK

/MP WOODWARD/  
Supervisory Patent Examiner, Art Unit 1615